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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/281,717	03/30/1999	JOHN D. BAXTER	9811-008-999	7561

7590 02/06/2003

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EXAMINER

MORAN, MARJORIE A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/281,717

Applicant(s)

BAXTER ET AL.

Examiner

Marjorie A. Moran

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1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 30-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 and 30-43 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16 and 30-33, drawn to a method of identifying a compound which binds to a coactivator binding site of a human thyroid beta receptor, classified in class 702, subclass 19.
- II. Claims 1 and 34-35, drawn to a method of identifying a compound which binds to a coactivator binding site of a human estrogen receptor, classified in class 702, subclass 19.
- III. Claims 1 and 36, drawn to a method of identifying a compound which binds to a coactivator binding site of hRAR $\gamma$ , classified in class 702, subclass 19.
- IV. Claims 1 and 37, drawn to a method of identifying a compound which binds to a coactivator binding site of hRXR $\alpha$ , classified in class 702, subclass 19.
- V. Claims 1 and 38, drawn to a method of identifying a compound which binds to a coactivator binding site of hPPAR $\gamma$ , classified in class 702, subclass 19.
- VI. Claims 1 and 39, drawn to a method of identifying a compound which binds to a coactivator binding site of hVDR, classified in class 702, subclass 19.

- VII. Claims 1 and 40, drawn to a method of identifying a compound which binds to a coactivator binding site of hGR, classified in class 702, subclass 19.
- VIII. Claims 1 and 41, drawn to a method of identifying a compound which binds to a coactivator binding site of hPR, classified in class 702, subclass 19.
- IX. Claims 1 and 42, drawn to a method of identifying a compound which binds to a coactivator binding site of hMR, classified in class 702, subclass 19.
- X. Claims 1 and 43, drawn to a method of identifying a compound which binds to a coactivator binding site of hAR, classified in class 702, subclass 19.

The inventions are distinct, each from the other because of the following reasons:

Groups I-X are each separate and distinct. A method using atomic coordinates and performing a binding assay with the human thyroid receptor necessarily requires different method steps (e.g. modeling compounds which fit into the binding site of a different receptor), use of different compounds (i.e. the different receptor), and would be expected to give different results than would a method using any other receptor, therefore the claims of each of Groups I-X are directed to separate and distinct methods. In addition, a search for a method using the human thyroid receptor is

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necessarily different from a search for a method using any other receptor. For these reasons, each Group is separate and distinct from every other Group.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### ***Specification***

Applicant is advised that the proposed amendments to the specification filed with the response of 11/18/02 have not been entered as they do not unambiguously identify the paragraph to be modified by page and line, as required by 37 CFR 1.121. It is noted that the proposed amendment refers to paragraph numbers found in a corresponding publication; however, as the instant specification does not disclose paragraph numbers, the amendment can not be entered. The amendments to the claims have been entered.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Friday, 7:30 am to 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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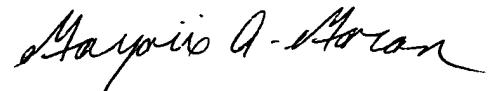
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308-4242 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3524.

MARJORIE MORAN  
PATENT EXAMINER

A handwritten signature in cursive script that reads "Marjorie A. Moran".

February 5, 2003